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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Harry W. Eberle, III Central RE Unit: 3993  
Serial No.: 09/186,741 Examiner: Jeffrey R. Jastrzab  
Filed: November 5, 1998 ExParte RE Control 90/007,661  
No.  
For: **ANCHORING BISCUIT DEVICE**  
Old Docket No.: HWE-105C  
New Docket No.: 0247-3 CIP RE

Bedminster, N.J. 07921  
September 17, 2007

Mailstop Petitions  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION FOR REVIVAL OF**  
**UNINTENTIONALLY ABANDONDED APPLICATION**  
**UNDER 37 C.F.R. 1.137(b)**

Applicant respectfully petitions, through his attorney of record, the Commissioner of Patents and Trademarks to revive the above-identified application and to reinstate prosecution of the ExParte Reexamination proceeding.

Applicant prepared and submitted on May 18, 2007 a Supplemental Amendment Under 37 CFR 1.550(b) in response to the Notice of Defective Paper in Ex Parte Reexamination dated May 8, 2007. The Supplemental Amendment was never received by the United States Patent And Trademark Office, and the application therefore became abandoned on June 8, 2007.

The entire delay in responding to the Notice was unintentional.

Applicant is resubmitting herewith a copy of the Supplemental Amendment and Response Under 37 CFR 1.550 (b) which was filed on May 18, 2007

09/20/2007 FRETAK11 00000031 09186741

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by date-certified First Class Mail in response to the Notice. The Supplemental Amendment presents arguments that are believed to place the application in condition for allowance. The revival is requested in order to provide sufficient time for the Examiner to consider the Amendment.

A check made payable to the Director of U.S. Patents and Trademarks in the amount of \$750 is enclosed to cover the \$750 fee associated with this Petition to Revive.

Respectfully submitted,

Harry W. Eberle, III

By



Ernest D. Buff

(His Attorney)

Reg. No. 25,833

(908) 901-0220

0247-3 CIP RE-PR



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re Application of:	Harry W. Eberle, III	Central RE Unit	3993
Serial No.:	09/186,741	Examiner:	Jeffrey J. Jastrzab
For:	<b>ANCHORING BISCUIT DEVICE</b>		
ExParte RE Control No.	90/007,661		
Old Docket No.:	HWE 105C		
New Docket No.:	0247-3 CIP RE		

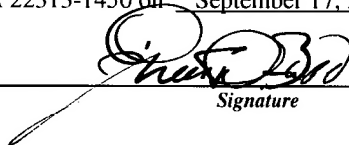
Ernest D. Buff & Associates, LLC  
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September 17, 2007

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**Certificate of Mailing by Express Mail**

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope bearing Express Mail Label No. EQ 1744 53 791 US addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 17, 2007.



Signature

**Ernest D. Buff**  
*Attorney of Record*

September 17, 2007  
(Date)



**EX PARTE REEXAMINATION CONTROL NUMBER 90/007,661**

In re application of:

HARRY W. EBERLE, III

Serial No. 09/186,741

Filing Date: November 5, 1998

Priority Date: March 5, 1997

For: ANCHORING BISCUIT DEVICE

: Examiner:

: JEFFREY R. JASTRZAB

: Central Reexamination Unit: 3993

: Attorney Docket No. HWE-105C

**U.S. Patent No. 6,402,415 B1**

Issue Date: June 11, 2002

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a complete copy of this Supplemental Amendment Under 37 CFR 1.550(b) was served on this 17th day of September 2007 upon the below-listed party of record, by mailing the same via United States First Class Mail in an envelope addressed to the Requester's attorney of record as follows:

Mathew W. Stavish  
BERENATO, WHITE & STAVISH, LLC  
6550 Rock Spring Drive, Suite 240  
Bethesda, Maryland 20817

Signature

Ernest D. Buff, Esq.  
Reg. No.: 25,833

Ernest D. Buff & Associates  
231 Somerville Road  
Bedminster, NJ 07920

## AMENDMENT TRANSMITTAL LETTER

ATTORNEY'S DOCKET NO.:

0247-3 CIP RE

SERIAL NUMBER:

09/186,741

FILING DATE:

November 5, 1998

EXAMINER:

Jeffrey R. Jastrzab

CENTRAL REEXAM UNIT:

3993

INVENTION:

ANCHORING BISQUIT DEVICE

INVENTOR(s): Harry W. Eberts, III

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is an amendment in the above-identified application. The fee has been calculated as shown below.

## CLAIMS AS AMENDED

(1)	(2) CLAIMS REMAINING AFTER AMENDMENT	(3)	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) NO. OF EXTRA CLAIMS PRESENT	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	26	MINUS	20	6	X \$25	\$ 150.00
INDEP. CLAIMS	4	MINUS	3	1	X \$100	\$ 100.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 250.00

\* If the entry in column 2 is less than the entry in column 4, write "0" in column 5.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.



No additional fee is required.



A Check for \$ \_\_\_\_\_ is enclosed to cover the fee for the additional claims.

The undersigned petitions for a one month time extension for filing this document under 37 C.F.R. 1.136  
A Check for \$ \_\_\_\_ Is enclosed to cover the fee for this time extension.

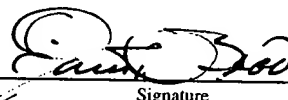
A triplicate copy of this sheet is enclosed.



Charge any additional fees to Deposit Account No. 50-3832

May 18, 2007

Date



Signature

Ernest D. Buff

Attorney Name


(908) 901-0220

Phone

25,833

Reg. Number

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 18, 2007.



(Signature)

Ernest D. Buff

Attorney of Record

May 18, 2007

(Date)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**CENTRAL REEXAMINATION UNIT**

**EX PARTE REEXAMINATION CONTROL NUMBER 90/007,661**



In re application of:

HARRY W. EBERLE, III

Serial No. 09/186,741

Filing Date: November 5, 1998

Priority Date: March 5, 1997

For: ANCHORING BISCUIT DEVICE :

U.S. Patent No. 6,402,415 B1

: Examiner:

: JEFFREY R. JASTRZAB

: Central Reexamination Unit: 3993

: Attorney Docket No. HWE-105C

:

: Issue Date: June 11, 2002

Honorable Commissioner of Patents  
P.O. BOX 1450  
Alexandria, VA 22313-1450

**SUPPLEMENTAL AMENDMENT AND RESPONSE UNDER 37 CFR 1.550(b)**

In response to the Office Action dated May 8, 2007 in the above-mentioned patent reexamination, the following amendments, remarks, declarations, and requests for reconsideration are submitted.

A statement of **Claim Status** is set forth on page 2 of this paper.

**Amendments to the Claims** are set forth beginning on page 3 of this paper.

A statement setting forth **Support for Amendments to the Claims** is provided beginning on page 9 of this paper.

**Remarks/Arguments** begin on page 12 of this paper.

**CERTIFICATE OF MAILING BY FIRST CLASS MAIL**

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

May 18, 2007  
Date of Deposit

Signature

Ernest D. Buff

Typed or Printed Name of Person Signing Certificate

ReExamination of USP 6,402,415  
Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 2

Attorney Docket No.: HWE-105C

**STATUS OF CLAIMS:**

The following is the current status of all claims in the subject reexamination proceeding:

<u>CLAIMS</u>	<u>STATUS</u>
1 through 12	Issued Patent Claims, pending in the present reexamination.
1, 2, 7, 8, 10	Amended as set forth hereinafter.
13 through 26	Newly presented by this Amendment.

### IN THE CLAIMS

Kindly amend claims 1, 2, 7, 8, and 10 and add new claims 13-26 as follows:

1. (amended) An anchoring biscuit device for joining [three ]together two adjacent boards and a support board, the adjacent boards being in the same plane and having in their sides pre-cut biscuit receiving slots, [which] the anchoring biscuit device comprising[comprises]:

(a) a first substantially flat horizontal top element having a generally biscuit-shaped top view configuration [with] having opposite side walls in the shape of arcs from a top view, said arcs having predetermined radii and arc lengths, and opposite end walls, said top element having a center [area between said opposite side walls in the shape of arcs]line extending between said end walls, and said respective side walls being adapted to be fitted into said respective biscuit receiving slots of said adjacent boards;

(b) at least two substantially vertical support members attached to an underside of said top element [at ]along said center [area] line of said top element and extending perpendicularly downwardly [there]from said top element for a predetermined length in a vertical plane that is aligned with, and directly under, said center line, said predetermined length being adapted to maintain said top element in a predetermined position during use for joining said two adjacent boards together with, and atop, said support board, [which have been pre-cut with biscuit receiving slots, two of ]all of said at least two vertical



support members being substantially flat[, being] and in [the same]said vertical plane  
[and one of each being located on opposite sides of an attachment orifice]; and,

(c) at least one attachment orifice located at least on said top element for  
attachment of said anchoring biscuit device to [a ]said support board for anchoring and  
support of said two adjacent boards, said attachment orifice being located between two of  
said vertical support members.

2. (amended) The anchoring biscuit device of claim 1 wherein said attachment  
orifice is at least one screwhole located on said top element for screwing of said  
anchoring biscuit device to [a]said support board.

7. (amended) The anchoring biscuit device of claim 1 wherein said top element  
and said vertical support members are unitarily formed.

8. (amended) The anchoring biscuit device of claim 1 wherein there are exactly  
two vertical support members[ and one is located on each side of said attachment orifice].

10. (amended) An anchoring biscuit device for joining [three ]together two  
adjacent boards and a support board, the adjacent boards being in the same plane and  
having in their sides pre-cut biscuit receiving slots, the anchoring biscuit device [which  
comprises]comprising:

(a) a first substantially flat horizontal top element having a generally biscuit-  
shaped top view configuration with opposite side walls in the shape of arcs from a top  
view, said arcs having predetermined radii and arc lengths, and opposite end walls, said  
top element having a center [area between said opposite side walls in the shape of arcs]

line extending between said end walls, and said respective side walls being adapted to be fitted into said respective biscuit receiving slots of said adjacent boards;

(b) at least one substantially vertical support member attached to an underside of said top element [at] along said center [area] line of said top element and extending perpendicularly downwardly therefrom for a predetermined length in a vertical plane that is aligned with, and directly under, said center line, said predetermined length being adapted to maintain said top element in a predetermined position during use for joining said two adjacent boards together with, and atop, said support board [which have been precut with biscuit receiving slots], said at least one vertical support member being substantially flat; and,

(c) at least one attachment orifice located at least on said top element for attachment of said anchoring biscuit device to a support board for anchoring and support of said two adjacent boards; and

wherein [there is] said at least one substantially vertical support member [which] is located off-center and to one side of said at least one attachment orifice.

13. (new) The anchoring biscuit device of claim 10 having exactly one said vertical support member.

14. (new) An anchoring biscuit device for joining together two adjacent boards and a support board, the adjacent boards being in the same plane and having in their sides pre-cut biscuit receiving slots, the anchoring biscuit device comprising:

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 6

(a) a first substantially flat horizontal top element having a generally biscuit-shaped top view configuration having opposite side walls in the shape of arcs from a top view, said arcs having predetermined radii and arc lengths, and opposite end walls, said top element having a center line extending between said end walls, and said respective side walls being adapted to be fitted into said respective biscuit receiving slots of said adjacent boards;

(b) exactly two substantially vertical support members attached to an underside of said top element along said center line of said top element and extending perpendicularly downwardly therefrom for a predetermined length in a vertical plane that is aligned with, and directly under, said center line, said predetermined length being adapted to maintain said top element in a predetermined position during use for joining said two adjacent boards together with, and atop, said support board, said vertical support members being substantially flat and in said vertical plane; and

(c) at least one attachment orifice located on said top element for attachment of said anchoring biscuit device to said support board for anchoring and support of said two adjacent boards, said attachment orifice being located between said vertical support members.

15. (new) The anchoring biscuit device of claim 14 wherein said attachment orifice is at least one screw hole located on said top element for screwing of said anchoring biscuit device to said support board.

16. (new) The anchoring biscuit device of claim 15 wherein said screwhole has a bevelled top.

17. (new) The anchoring biscuit device of claim 15 wherein said screwhole is non-circular and elongated.

18. (new) The anchoring biscuit device of claim 14 wherein said top element and said vertical support member are unitarily formed.

19. (new) The anchoring biscuit device of claim 14, having exactly one said attachment orifice.

20. (new) An anchoring biscuit device for joining together two adjacent boards and a support board, the adjacent boards being in the same plane and having in their sides pre-cut biscuit receiving slots, and wherein the anchoring biscuit device comprises:

(a) a first substantially flat horizontal top element having a generally biscuit-shaped top view configuration with opposite side walls in the shape of arcs from a top view, said arcs having predetermined radii and arc lengths, and opposite end walls, said top element having a center line extending between said end walls, and said respective side walls being adapted to be fitted into said respective biscuit receiving slots of said adjacent boards;

(b) exactly one substantially vertical support member attached to an underside of said top element along said center line of said top element and extending perpendicularly downwardly therefrom for a predetermined length in a vertical plane that is aligned with, and directly under, said center line, said predetermined length being adapted to maintain

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 8

said top element in a predetermined position during use for joining said two adjacent boards together with, and atop, said support board, said at least one vertical support member being substantially flat; and,

(c) at least one attachment orifice located at least on said top element for attachment of said anchoring biscuit device to a support board for anchoring and support of said two adjacent boards; and

wherein said substantially vertical support member is located off-center and to one side of said at least one attachment orifice.

21. (new) The anchoring biscuit device of claim 20 wherein said attachment orifice is at least one screwhole located on said top element for screwing of said anchoring biscuit device to said support board.

22. (new) The anchoring biscuit device of claim 21 wherein said screwhole has a bevelled top.

23. (new) The anchoring biscuit device of claim 21 wherein said screwhole is non-circular and elongated.

24. (new) The anchoring biscuit device of claim 20 wherein said top element and said vertical support member are unitarily formed.

25. (new) The anchoring biscuit device of claim 20, having exactly one said attachment orifice.

26. (new) The anchoring biscuit device of claim 25, wherein said attachment orifice is situated on said center line.

### **SUPPORT FOR CLAIM AMENDMENTS**

Support for the claim amendments presented in this paper is provided by the specification of the original application and the issued patent as follows. Consequently, no new matter has been added by the present amendment.

**Claim 1:**

Claim 1 as originally filed;

Col. 1, lines 18-19; col. 4, lines 24-25; col. 5, lines 4-5, 10, 24-25, 29-31, 31-33,  
and 39;

Figs. 1, 4, 5.

**Claim 7:**

(typographical error).

**Claim 8:**

Figs. 1, 2, 6, 7.

**Claim 10:**

Col. 1, lines 18-19; col. 4, lines 24-25; col. 5, lines 4-5, 10, 24-25, 29-31, 31-33,  
and 39; col. 6, lines 35-37;

Fig. 11.

**Claim 13:**

Col. 6, lines 35-37;

Fig. 11.

**Claim 14:**

Claim 1;

Col. 1, lines 18-19; col. 4, lines 24-25; col. 5, lines 4-5, 10, 13-22, 24-25, 29-31,  
31-33, and 39;

Figs. 1, 4, 5.

Claims 15-17:

Claims 2-4, respectively.

Claim 18:

Claim 8 as originally filed;

Claim 7.

Claim 19:

Col. 5, lines 17-19;

Figs. 1-3.

Claim 20:

Claim 10;

Col. 1, lines 18-19; col. 4, lines 24-25; col. 5, lines 4-5, 10, 24-25, 29-31, 31-33,  
and 39; col. 6, lines 35-37;

Fig. 11.

Claims 21-23:

Claims 2-4, respectively.

Claim 24:

ReExamination of USP 6,404,415  
Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 11

Attorney Docket No.: HWE-105C

Claim 8 as originally filed;

Claim 7.

Claim 25:

Col. 5, lines 17-19;

Figs. 1-3.

Claim 26:

Fig. 11.



### REMARKS

In the Office Action dated May 8, 2007, in the instant *Ex Parte* Reexamination proceeding, the Examiner has indicated that the Patent Owner's response filed February 9, 2007, was not compliant with the requirements of 37 CFR 1.530(d)-(j). Specifically, the Examiner indicated that the claim listing did not employ single brackets enclosing text to be deleted from the claims as originally issued. The Examiner set a one month period for the Patent Owner to correct the informality.

Provided herewith is a replacement claim listing that is believed to be in compliance with the formal requirements of 37 CFR 1.530(d)-(j) and MPEP 2250 I.B. The claim listing includes amended claims 1, 2, 7, 8, and 10 and newly presented claims 13-26. Each of the claims is amended so that text to be omitted is enclosed within single brackets and text to be added is underlined. The text of the amended and newly presented claims is otherwise identical to that included in the February 9, 2007 response.

For the convenience of the Examiner, the present amendment further includes sections of the February 9, 2007 response entitled "Claim Status" and "Support for Amendments to the Claims". These sections repeat verbatim the corresponding sections that were included in the amendment dated February 9, 2007.

The present amendment further includes the remarks set forth below in support of the patentability of claims 1-12 of the issued '415 patent, as presently amended, and new claims 13-26. These remarks are substantially identical to those provided in the February

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 13

9, 2007 that was deemed non-compliant, and are submitted herewith for the Examiner's convenience. In view of the present claim amendments, the remarks hereinbelow, and the Declarations under 37 CFR 1.132 by Harry W. Eberle, III, and Kevin Sabin filed on February 9, 2007, it is respectfully submitted that claims 1-26 are in allowable condition.

In order to emphasize the patentable distinctions of the Patentee's contribution over the prior art of record, claims 1 and 10 have been amended to recite an anchoring biscuit device for joining together two adjacent boards and a support board, wherein the adjacent boards are in the same plane and have in their sides pre-cut biscuit receiving slots. The anchoring device has a substantially flat horizontal top element having a generally biscuit-shaped top view configuration with opposite side walls in the shape of arcs from a top view, the arcs having predetermined radii and arc lengths, and opposite end walls. The top element has a center line extending between the end walls. The respective side walls are adapted to be fitted into the respective biscuit receiving slots of the adjacent boards. Amended claim 1 further calls for at least two substantially vertical support members attached to an underside of the top element along the center line of the top element. The vertical support members extend perpendicularly downwardly from the underside of the top element for a predetermined length in a vertical plane that is aligned with, and directly under, said center line. The predetermined length is adapted to maintain the top element in a predetermined position during use for joining the two adjacent boards together with and atop the support board. The at least two vertical

support members are substantially flat and in the same vertical plane. One of the vertical support members is located on each side of an attachment orifice.

Claim 8 has been amended to emphasize the patentable distinctions of the Patentee's contribution to the art and for the sake of clarity. Claim 8 now calls for exactly two vertical support members. The recitation that the two vertical support members are located on the sides of the attachment orifice has been removed as being redundant, this feature now being recited by claim 1.

Claims 2 and 7 have been amended for the sake of clarity. In claim 2, the antecedent basis for the support board has been clarified. The word "member" in claim 7, an obvious typographical error, has been corrected to the plural form "members."

New claims 13-26 have been added to provide adequate coverage for the Patentee's contribution to the art.

Claim 13, dependent from claim 10, calls for exactly one vertical support member.

New independent claim 14 parallels amended claim 1, but calls for exactly two vertical support members. Claims 15-18 depend from claim 14 and recite preferred embodiments paralleling those of claims 2-4 and 7. Dependent claim 19 calls for an anchoring biscuit device having exactly one attachment orifice.

New independent claim 20 parallels amended claim 10, but calls for exactly one vertical support member. Claims 21-24 depend from claim 20 and recite preferred embodiments paralleling those of claims 2-4 and 7. Dependent claim 25 calls for an

anchoring biscuit device having exactly one attachment orifice. Claim 26 depends from claim 25 and calls for the attachment orifice to be on the center line of the device.

Support for the foregoing amendments is provided by the patent as issued and the specification, including claims, as originally filed, particularly as set forth hereinabove. Consequently, no new matter has been added.

Attention is respectfully drawn to two Declarations Under 37 CFR 1.132 filed in the present reexamination proceedings on February 9, 2007. The first declaration is made by Harry W. Eberle, III, the patentee of the present patent. The other declaration is made by Kevin Sabin. The Declarations include exhibits including certain printed and recorded materials pertinent to the determination of patentability of the subject matter delineated by the pending claims. Based on the qualifications and the experience of the declarants, as set forth in their respective declarations, the patent owner respectfully submits that each declarant is a person having at least ordinary skill in the art to which the present patent pertains.

**Issue 1:**

Claims 1-3, 5, and 7-11 were rejected under 35 USC 102(b) as being clearly anticipated by US Patent No. 2,201,129 to Weiland, which relates to a tiling system that includes means for positive mechanical attachment of ceramic or composition tiles to a surface without use of cement.

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 16

As amended, claims 1 and 10 respectively call for an anchoring biscuit device for joining together two adjacent boards and a support board. The adjacent boards are in the same plane and have in their sides pre-cut biscuit receiving slots. A person having ordinary skill in the deck construction arts would regard the use of a conventional biscuit jointer as disclosed by US Patent 5,004,027 to Legler et al. (see col. 2, lines 45-64 of the present patent) as one possible and convenient means of forming the present biscuit receiving slot.

The claim 1 device comprises at least two substantially vertical support members, while the claim 10 device comprises at least one substantially vertical support member that is located off-center and to one side of the attachment orifice. Amended claims 1 and 10 further call for the vertical support members: (i) to be attached to an underside of the top element along a center line of the top element that extends between the end walls; and (ii) to extend perpendicularly downward from the top element in a vertical plane that is aligned with, and directly under the center line. Newly presented claims 14 and 20 call for exactly two and exactly one such vertical support member in the same relationship to the top element.

The Patent Owner maintains that the foregoing features unambiguously distinguish the structure of claims 1, 10, 14, and 20, and the claims dependent thereon, from any device disclosed by Weiland.

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 17

In particular, the Weiland devices includes structural features that contravene the structural requirements of the present claims and preclude it from carrying out the function provided by the instant patent's claimed device.

By way of contrast, the Examiner has adapted the arguments of the third party requester and has interpreted the claim language of the issued claims rather broadly, both as to the meanings of the words used by patentee, and the context of the phrases used by patentee. Thus, it appears that the Examiner has construed the claim language in a manner that is inconsistent with what would be understood by a person having ordinary skill in the art in the context of the application as filed, taken as a whole.

For example, the patentee submits that the Examiner has misinterpreted the recitation of a vertical support member "extending down at the center area of the top element". The requester and the Examiner have taken the phrase "center area between said side walls" to mean the entire area between said sidewalls. See, for example, the Office Action of December 14, 2006, at page 8, lines 12-13. This interpretation is unsupportable for many reasons.

First, this interpretation that the area between the side walls in its entirety is the "center area" ignores the existence of the word "center". Had the claim phrase said that the vertical support members were extending down at the area between the side walls, then this interpretation makes sense. However, the Examiner's position fails to recognize any limitation resulting from the inclusion of this term and thereby impermissibly strips the word "center" of any meaning whatsoever.

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 18

In the present instance, the term “center area” is used with respect to the top element, but in conjunction with other portions thereof, including the “end” and “sides.” These terms, as used by the patent specification, provide context that must figure in any construction of the particular meaning of the term “center area.” It is respectfully submitted that the Examiner’s expansive reading, being incompatible with these distinctions, is untenable.

Second, the context within which the term “center area” is used clearly means an area that includes the center line. The devices provided by Weiland’s Figs. 6 and 11 do not have vertical support members in the center area and thus cannot be construed as satisfying the limitations of issued claim 1.

Nevertheless, for the sake of clarity, claims 1 and 10 have been amended to call for the substantially vertical support members of the Eberle device to extend downwardly from a center line of the top element, a feature Weiland clearly does not disclose. New claims 14 and 20 incorporate the same recitation.

The Patent Owner also maintains that claims 1, 10, 14, and 20 include further structural recitations, albeit delineated in functional terms. The propriety of a claim recitation in this form is well established. See, e.g., *Sanada v. Reynolds*, 67 USPQ2d 1459, 1463 (B.P.A.I. 2003) (unpublished) [“There is nothing wrong with using functional claim language, where the means-plus-function provision of 35 U.S.C. § 112 applies or where such functional language further limits structure or composition already defined in

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 19

the claim.” citing *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971), emphasis added].

The Patent Owner concurs with the Examiner’s statement that “The Weiland device need only be inherently capable of providing the claimed function to read on the claim language,” but maintains that this very standard operates to preclude any novelty rejection of the patent claims over the Weiland device. Specifically, the Patent Owner maintains that the recited intended use of the present anchoring device (“to joint together two adjacent boards and a support board,” as further elucidated by the remainder of the claims), imposes structural requirements that the Weiland devices inherently does not satisfy. The failure to satisfy these requirements is manifest by the Weiland device’s inability to carry out the present patent’s anchoring function.

Attention is respectfully directed to the tiling installations depicted by Figs. 1 and 8 of Weiland. In the Fig. 1 arrangement, square tiles are disposed in a simple pattern wherein four tiles meet with their corners at a common vertex. Attachment devices of the form of Fig. 4 or 6 are situated at the right angle vertex. Slots 8 to accommodate the attachment devices are located at the corners of tiles A, not their sides. The Fig. 4 and 6 devices thus provide for the attachment of five workpieces (four tiles to a support structure). The staggered tile disposition in Fig. 8 employs the modified device of Fig. 10 at a vertex at which three tiles meet and are secured to a support structure. However, the device only engages slots in two of the tiles, but again only at their corners.



The Examiner has correctly recognized that Weiland's Fig. 6 device has projections equally spaced at 90° intervals around a generally circular configuration. Even the Fig. 11 device, which is a portion of the Fig. 6 device, has these mutually perpendicular projections. As a result, Weiland only provides devices that can engage a tile having a corner slot, like slot 8 of tiles A. The presence of perpendicular projections inherently precludes insertion of any Weiland device into a biscuit receiving slot cut into the side of a decking board.

By way of contrast, claims 1 and 14 respectively call for a device having at least two, or exactly two, vertical support members, that lie in a vertical plane that is aligned with, and directly under, the device center line. The claims additionally call for the at least two, or two, support members to be substantially flat and in "said vertical plane."

Clearly, none of the Weiland attaching means satisfies these requirements. The projections of the Weiland device are provided in pairs. The various pairs lie in parallel planes, and so do not lie in a vertical plane aligned with, and directly under any center line. Moreover, as the Examiner has recognized, the Weiland projections are spaced at 90° angles, thereby locating them in multiple, mutually perpendicular planes, not in a single plane. Furthermore, the orifice in the devices of Weiland's Figs. 6 and 11 is not between two of said vertical support members; it is not disposed on a line that is collinear with any of the projections, thus the orifice is not "between" the members.

Because the Weiland devices are structurally different from those claimed by Eberle, they cannot anticipate the Eberle invention. The present amendment to the claims

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 21

only emphasizes the radical and fundamental structural differences between the Eberle and Weiland attachments.

Further, although the Examiner implies that intended use and operability are irrelevant, patentee wishes to re-emphasize that the devices of Weiland are so different from the Eberle devices that the Weiland devices would be inoperative for the Eberle purposes, and likewise, the Eberle devices could not function effectively for the Weiland purposes. If modified to satisfy the Eberle purpose, the Weiland device would no longer be useful for its intended purpose. In order to carry out their intended function, the Weiland devices necessarily have the radially extending plates or flanges that are at right angle to each other and inherently create products that cannot be slipped into a biscuit cut or wood slot, because, as can be seen from the Weiland drawings, there are no single plane vertical members that would create a single plane top area that could fit into a saw cut, biscuit cut or slot in a side of wood. The Eberle device, on the other hand, is appointed for "use for joining two adjacent boards which have been precut with biscuit receiving slots." See, e.g., feature (b) of claim 1, and claim 10, and of new claims 14 and 20. Accordingly, the Weiland reference cannot be construed to render the Eberle claims obvious in view of *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Weiland's devices are built specifically for corner engagement and can only be used at points where two or four tiles meet with their corners at a common vertex. The devices have downwardly projecting and outwardly projecting members that totally

prevent the insertion of the device into a slot, whereas the Eberle devices as claimed are specifically structured to fit into a side slot of wood or synthetic wood.

Hence, no device disclosed by Weiland can anticipate the Eberle device, since the downwardly projecting members would preclude the receipt of the Weiland device by a biscuit receiving slot.

In order for the Weiland device to accomplish the function provided by the Eberle device, it would have to be reconstructed by removing certain of its critical elements, e.g. two of the channels 13 of Fig. 4 or four of the flanges 13a of Fig. 6, to leave two generally collinear portions on either side of attachment hole 12. Such a reconstruction is submitted to be substantial, precluding a finding of obviousness under *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Moreover, once modified in this manner, the Weiland device would be rendered inoperable for the disclosed function of attaching tiles at their corners, further precluding any finding of obviousness.

The function afforded by the Weiland device, viz. the securing of generally square or rectangular tiles at their corners presents a significantly different problem than the securing of deck boards. As would be known to one of ordinary skill in the carpentry and deck building arts, wooden deck boards, which are typically disposed outdoors and exposed to the elements, including rain and snow and relatively large temperature and humidity excursions, undergo significant dimensional changes. Moreover, deck boards are often many feet long, in some cases as long as sixteen feet or more. If secured merely at their corners, as would necessarily be the case using a securing device such as that of

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 23

Weiland, the deck boards would be subject to marked deformation, warping, bowing, or the like. Such deformation would be highly detrimental and aesthetically unacceptable, and would likely lead to premature failure of the board. The attachment would be highly tenuous, potentially leading to the board becoming disengaged and a serious safety hazard. On the other hand, the Eberle device is employed for securing the board at regular intervals along its length, virtually eliminating the foregoing deformation and providing a much more stable and secure attachment.

Thus, Weiland's devices have different structures from the present invention, that (i) function differently from the present invention, and (ii) are used for a different purpose than the present invention. These considerations would discourage a person having ordinary skill in the art from any motivation to carry out the modification of the Weiland devices needed to reach the Eberle device. Accordingly, it is submitted that Weiland neither discloses the present invention nor renders it obvious.

Attention is respectfully drawn to both Rule 132 declarations submitted herewith. The Patent Owner maintains that each declaration separately sets forth bases that further confirm that Weiland neither discloses nor suggests the subject matter of claims 1-3, 5, and 7-11, and that a person having ordinary skill in the art would not have had motivation to modify the Weiland attachment device by removing features thereof, as would be required to reach the present claimed anchoring biscuit device..

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 24

Accordingly, reconsideration of the rejection of claims 1-3, 5, and 7-11 under 35 USC 102(b) as being clearly anticipated by Weiland is respectfully requested, along with confirmation of said claims, as amended, and allowance of newly presented claims 13-26.

In view of the foregoing arguments, the newly presented claims and the Declarations supporting patentability that are appended hereto, it is urged that this rejection be withdrawn and that the new claims be allowed.

**Issue 2:**

Claims 4, 6, and 12 were rejected under 35 USC 103(a) as being unpatentable over Weiland in view of German Patent Document DE372,483 to Wothe, which relates to a screw supporting plate used in conjunction with a screw that attaches a beam for a crossing wood member.

The Examiner has alleged that Weiland discloses the invention substantially as claimed less a non-circular and elongated slot. For the reasons set forth above under Issue 1 in connection with the novelty rejection over Weiland, the Patent Owner respectfully disagrees. In particular, it is submitted that Weiland does not disclose or suggest the subject matter of amended claims 1 and 10, on which claims 4 and 6, and 12 respectively depend.

The Examiner has not pointed to any disclosure or suggestion that cures this deficiency, but instead merely relies on Wothe for the feature of the non-circular and

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 25

elongated slot to allege that the modification of Weiland to include such a slot as part of the attachment orifice would be obvious to a skilled artisan.

The patentee respectfully submits that the screw supporting plate of the Wothe reference clearly engages only the cross-bar member "b" of Figs. 1-2 in Wothe and the attaching screw itself. The plate does not play any direct role in the mutual engagement of multiple boards. By way of contrast, the patentee's anchoring device directly engages two adjacent decking boards and is attached to the third board member by a fastener such as a screw. As a result, the Wothe reference, whether taken singly or in combination with Weiland, does not cure the lack of disclosure or suggestion of the particular arrangement of the at least two vertical support members, in the form delineated by amended claim 1, which feature is inherited by claims 4 and 6, or the at least one vertical support member of amended claim 10, on which claim 12 depends.

Moreover, the slotted orifice in the Wothe plate functions in an altogether different way than the slotted orifice delineated by the patentee's claims. In particular, slotting is said by the present patent to permit insertion of a screw or the like at an angled, non-vertical position. See, e.g., col. 4, lines 30-34, col. 6, lines 1-3, and Figs. 7 and 9. Such a non-vertical installation typically has been found to provide additional support and integrity to the deck flooring structure, inasmuch as the fastener directly engages both the supporting beam and one of the deck boards, instead of just the beam, as it would if the fastener were driven vertically. On the other hand, the elongated plate in the Wothe reference merely permits the screw position to be moved horizontally, while

maintaining a vertical disposition of the screw itself. In addition, the screw itself in the Wothe construction provides the principal alignment and fastening of the cross-member and the long beam, and not vertical support members provided by the Eberle device..

In view of the aforesaid differences, it is submitted that even in combination, Weiland and Wothe do not disclose or suggest the subject matter of amended claims 4, 6, and 12. Neither would a skilled artisan be motivated to carry out the substantial reconstruction of any structure provided by the combination of Weiland and Wothe that would be required to reach the anchoring device of present claims 4, 6, and 12. It is submitted that prima facie obviousness of claims 4, 6, and 12 has not been established.

Accordingly, and in view of the foregoing arguments, the newly presented claims and the Declarations supporting patentability that are appended hereto, reconsideration of the rejection of claims 4, 6, and 11 under 35 USC 103(a) as being unpatentable over Weiland and Wothe is respectfully requested, along with confirmation of said claims, as amended, and allowance of newly presented claims 13-26.

**Issue 3:**

Claims 10 and 11 were rejected under 35 USC 103(a) as being unpatentable over US Patent No. 1,714,738 to Smith in view of US Patent No. 2,337,156 to Elmendorf.

Smith is directed to a construction of floorboards and a means of fastening such boards to a subflooring. Elmendorf provides a system for laying a flooring of wood tiles on a wood or concrete subfloor without the necessity of employing tongue and groove

joints between meeting tiles, and with the assurance that the upper faces of meeting tiles lie in the same plane.

The Examiner has accepted the requester's contention that Fig. 3 of Smith depicts an anchoring device having, inter alia, a flat horizontal top element, vertical support members, and an attachment orifice as delineated by the issued claims. The Examiner acknowledges that the top view shape of the Smith device is rectangular, rather than the claimed biscuit shape. Accordingly, he has pointed to Elmendorf to contend that it would be obvious to change the shape of the Smith top configuration. The Patent Owner respectfully traverses this characterization.

Amended claim 10 and new claim 20 both call for an anchoring biscuit device having a vertical support member that extends perpendicularly downwardly from the device's top element in a vertical plane that is aligned with, and directly under, a center line.

Clearly, Smith provides no such structure. Both Figs. 3 and 4 of Smith depict devices wherein two vertical projections (e.g., supports or feet 11 of Fig. 3 and feet 20 of Fig. 4) extend downwardly from plural lines on the top element, neither of which is a center line.

The Patent Owner observes that Smith variously discloses "support means" and "support feet" associated with his fastener. Inasmuch as there is no disclosure, either by way of drawing illustration or textual description, of any support means that does not entail two support feet, the term "support means" must be construed as requiring two



Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 28

support feet laterally separated from the centerline of the Smith fastener. On the other hand, the Elmendorf keys (e.g. item 8 of Figs. 4 and 8) do not include any downward projection, so that Elmendorf cannot be regarded as providing any motivation for modifying the Smith device to remove some, but not all, of the downward projection therefrom.

Smith further discloses that “Feet 11 engage the subflooring and serve to hold the fasteners straight and to keep them from being bent downward either accidentally or when the nails are being driven. The provision of a means, such as the feet 11, for supporting the fasteners from the sub-flooring so as to positively position them is one important feature of my construction, for by this means the fasteners are all held straight so that when the next board is put in position no difficulty is experienced in fitting its grooves onto the outwardly-projecting flanges of the fasteners.” (Page 1, col. 2, lines 99-111, emphasis added). The feet are said to be “spaced.” (Page 1, col. 1, line 36).

The patentee respectfully submits that these disclosures, taken in combination, constrain what a skilled person would recognize as being the scope of the Smith disclosure. Specifically, the lateral spacing between the feet of the Smith fastener (e.g. between feet 11 of Fig. 3 or feet 20 of Fig. 4) must be relatively wide, so as to provide the aforementioned required stability of the table-like top surface of the fastener (e.g., surface 10 of Fig. 3 and surface 22 of Fig. 4). It is clear from the floor assembly depicted by Figs. 1-2 that the lateral spacing of the feet in turn establishes the width of undercut 17 (see page 1, col. 2, lines 79-80) required for the top edges of adjacent flooring boards to

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 29

be installed in abutment, to avoid cracks between boards. Such cracks are eschewed for interior wood floors (see page 2, col. 1, lines 61-62).

On the other hand, if a Smith fastener with such a width were to be used for installing deck boards having but a single rectangular groove or biscuit receiving slot, such as those employed by the patentee, the lateral spacing of the Smith feet would necessarily establish the open spacing between adjacent deck boards. Some amount of spacing (typically of the order of  $3/32 - 1/8$ ") is conventionally employed in both prior art forms of deck assembly and in the patentee's deck assembly system. However, it is submitted that the Smith fastener, which must have spacing sufficient to maintain the aforementioned stability, would result in an excessive spacing between adjacent boards in a decking installation. The typical small spacing of deck boards, which are ordinarily installed outdoors or in damp locations, accommodates the swelling and shrinking of lumber due to varying temperature and moisture, but is not large enough to present hazards, such as tripping or catching a narrow shoe heel. Installation of deck flooring with the Smith fasteners thus could not be readily accomplished with boards having biscuit receiving slots or a single groove. Instead, an additional step of rabbeting each deck board would be required to provide a sufficient undercutting to achieve the desired board spacing. These width considerations are submitted to negate any motivation for a skilled artisan to modify the Smith fastener in the manner required to reach the Eberle device.

The patentee further traverses the basis on which the Examiner discounted arguments based on the decision of the Board of Patent Appeals and Interferences. Specifically, the patent owner's answer argued that the same considerations on which BPAI ruled the Eberle application patentable over Ellinwood also apply with respect to the present rejection over Smith and Elmendorf. The Examiner countered as follows:

Patent Owner's Comments with respect to the BPAI decision in the Eberle patent are noted, however the comments are related to an anticipation rejection of a biscuit shape. This rejection is an obviousness rejection that acknowledges that the T-shaped top of the Smith anchor is not biscuit-shaped and thus is in-line with the BPAI comments on the Elmendorf\* patent. Accordingly, the modification in this rejection is not addressed. (page 21, second full paragraph of the present Office Action, emphases added)

The patentee respectfully submits that the Examiner has mischaracterized the BPAI decision, which did not relate to an anticipation rejection, but to an obviousness rejection. There were three issues before the Board in the aforementioned appeal: (i) rejection of claims 27-29 under 35 USC 112, second paragraph; (ii) rejection of claims 18, 19, and 24 under 35 USC 103(a) over US Patent 2,362,252 to Ellinwood in view of US Patent 5,529,428 to Bischof; and (iii) rejection of claims 20-23, 28, and 29 under 35 USC 103(a) over Ellinwood in view of Bischof and German Patent DE 372,483 (i.e., the present Wothe reference). Contrary to the Examiner's statement, the BPAI addressed Ellinwood in the context of obviousness, not novelty.

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\* *Sic.* The BPAI decision does not address Elmendorf. The Examiner may have intended reference to Ellinwood.

Attention is respectfully drawn to the BPAI decision at pages 4-6. Like the Smith and Heilmann devices, the Ellinwood connecting member is said to have a “general T-like formation...comprising a base 24 and side flanges 25” (page 2, col. 1, lines 40-42 and Figs. 2-4 of Ellinwood). The Ellinwood member is appointed for connecting adjacent panels forming a wall structure installation. The original Examiner’s position in the appeal expressly acknowledged that Ellinwood did not disclose a biscuit-like configuration having side walls in the shape of an arc having radii and an arc length (Examiner’s Answer at page 5, lines 3-4). Therefore, the original Examiner pointed to Fig. 9 of Bischof, which he alleged to provide the requisite shape in what he purported to be an anchoring device to obtain this feature. The Board’s decision thus addressed the obviousness of the Eberle device over Ellinwood in combination with Bischof.

The Board rejected the original Examiner’s arguments on several bases, including a finding that the proposed motivation for the combination was impermissibly hindsight-driven. In addition, the Board held that:

“even if Ellinwood and Bischof were combined in the manner proposed, the result would still not respond to the limitation in claim 18 requiring ‘at least two’ substantially vertical support members attached to an underside of the top element or the limitation in claim 27 requiring the vertical support member to be ‘located off-center and to one side of’ an attachment orifice. These flaws in the basic Ellinwood-Bischof combination find no cure in the German reference.” (page 6, full paragraph of BPAI Decision of August 27, 2001).

The patentee maintains this finding is directly apposite the rejection in present Issue 3. While the Board admittedly rejected the Examiner’s friction motivation to

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 32

permit the combination, the Board did not countenance or affirm any alternative motivation for the combination. In particular, the Board did not adopt the position the present Examiner urges, which seemingly relies on a *per se* rule that a change in shape of the top element of Smith to a biscuit-like shape is inherently motivated and renders the claims on appeal obvious. The courts have expressly rejected such reliance on *per se* rules. See., e.g., *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (1995). [“Reliance on *per se* rules of obviousness is legally incorrect and must cease.”] At best, the BPAI permitted the combination *arguendo*, but still ruled for no obviousness, without affirming the propriety of the combination.

The Examiner has pointed to Elemendorf at page 3, col. 2, lines 8-15 for the proposition that Elmendorf discloses a top shape that may be square, circular, or any other desired shape. The patentee acknowledges this statement, but submits that it pertains directly only to devices that are otherwise flat, i.e., without the vertical support members provided by the Eberle device. The only vertical element in any way associated with the Elmendorf device is a nail, which cannot constitute a vertical support member, and, in any event, cannot be regarded as adjacent an attachment orifice. The Elmendorf disclosure fails to contemplate any such members, despite the availability of the Smith reference, which issued some twelve years before the Elmendorf filing. The patentee thus submits that the combination of a non-rectangular shape like Elmendorf's, disclosed only in the context of a flat securing device, with devices like Smith's, which include both horizontal and vertical members, is possible only using impermissible hindsight.

The Patent Owner further submits that Elmendorf, like Weiland, discloses devices appointed only to engage workpieces either at their beveled corners, in an arrangement of square or rectangular tiles (e.g. Figs. 2, 7, and 14), or at complementary right-angled vertices in a herringbone arrangement (e.g. Fig. 18). Elmendorf fails to disclose or suggest any fastener that engages adjacent boards at any point along shared parallel edges. Instead, the fasteners are disposed only at vertices having an interior or exterior opening angle of 90°. Thus, Elmendorf does not provide a fastener that is to be received in the side's biscuit-receiving slots in adjacent boards, as required by the Eberle claims.

Significantly, the Third Party Requestor, in arguing a rejection over Smith and Elmendorf, points to Smith's phrase that the flanges "may be made in various forms," but extends this quotation beyond its context, which clearly does not include any disclosure of top shapes other than rectilinear forms (see, e.g., Figs. 3-4). (Request, page 6, line 4, citing Smith, page 2, col. 2, lines 74-75).

Second, the patentee maintains that the Smith-Elmendorf combination, like the Ellinwood-Bischof combination considered in the original appeal, does not respond to the "off-center and to one side of an attachment orifice" limitation recited by amended claims 10-11, or by new claims 20-26.

Were the Smith fastener to be modified as required to reach present claims 10-11 by removing one of its support feet and locating the remaining foot off center, it clearly would lose the stability said to be an important feature, thereby negating the motivation to make such modification.

The Examiner's attention is respectfully drawn to the Rule 132 Declaration of Kevin Sabin. The Patent Owner submits that the Declaration provides additional bases establishing that even in combination, Smith and Elmendorf do not disclose or suggest the subject matter of claims 10-11. The Sabin Declaration further provides evidence tending to establish that a person having ordinary skill in the art would not have had motivation to modify the combined teaching of Smith and Elmendorf as would be required to reach the present claimed anchoring biscuit device.

Accordingly, and in view of the foregoing arguments, the amended and newly presented claims, and the Declarations supporting patentability that are appended hereto, reconsideration of the rejection of claims 10-11 under 35 USC 103(a) as being unpatentable over Smith and Elmendorf is respectfully requested, along with confirmation of said claims, as amended, and allowance of newly presented claims 13-26.

The Patent Owner concurs with the Examiner's rejection of the Requestor's proposal that Claims 1, 2, 3, 5, and 7-9 be rejected on the same grounds. Clearly, the subject matter of claims 1, 2, 3, 5, and 7-9 is not disclosed or suggested by Smith and Elmendorf, whether taken singly or in combination.

**Issue 4:**

Claim 12 was rejected under 35 USC 103(a) as being unpatentable over Smith in view of Elmendorf and further in view of Wothe.

For the reasons set forth above concerning Issue 3, the patentee respectfully maintains that the combination of Smith and Elmendorf does not render obvious amended claim 10, from which claim 12 depends. The patentee's discussion of Wothe set forth under Issue 2 above is submitted to apply to the present rejection of claim 12 with equal force. Clearly, Wothe does not cure the lack of disclosure or suggestion of any anchoring biscuit device of base claim 10 provided by Smith and Elmendorf, even in combination.

In addition, the remarks set forth under Issue 3 regarding the pertinence of the earlier BPAI decision with respect to the rejection of claims 10-11 over Smith and Elmendorf apply with equal force to claim 12. The BPAI specifically considered the further combination with Wothe with Ellinwood and Bischof in regard to claim 12, and ruled for patentability. The patentee maintains that patentability of claim 12 over Smith, Elmendorf, and Wothe can be predicated on a comparable basis.

The patentee thus maintains that amended claim 12 is neither disclosed nor suggested by the combination of Smith, Elmendorf, and Wothe.

In view of the foregoing arguments, the amended and newly presented claims, and the Declarations supporting patentability that are appended hereto, it is submitted that the subject matter of claim 12 is patentable over the combination of Smith, Elmendorf, and Wothe.

Accordingly, reconsideration of the rejection of claim 12 under 35 USC 103(a) as being unpatentable over Smith, Elmendorf, and Wothe, and confirmation of amended claim 12, together with newly presented claims 13-26 are respectfully requested.



The Patent Owner concurs with the Examiner's rejection of the Requestor's proposal that Claims 4 and 6 be rejected on the same grounds. Clearly, the subject matter of claims 4 and 6 is not disclosed or suggested by Smith, Elmendorf, and Wothe, whether taken singly or in any combination.

**Issue 5:**

The Patent Owner concurs with the Examiner's rejection of the Requestor's proposal that Claims 1, 2, 7, 8, and 9 be rejected under 35 USC 103(a) as being unpatentable over US Patent 695,722 to Heilmann in view of Elmendorf. Clearly, the subject matter of claims 1, 2, 7, 8, and 9 is not disclosed or suggested by Heilmann and Elmendorf, whether taken singly or in combination.

**Issue 6:**

The Patent Owner concurs with the Examiner's rejection of the Requestor's proposal that Claims 3-6 be rejected under 35 USC 103(a) as being unpatentable over Heilmann in view of Elmendorf and further in view of Wothe. Clearly, the subject matter of claims 3-6 is not disclosed or suggested by Heilmann, Elmendorf, and Wothe, whether taken singly or in any combination.

**Issue 7:**

Claims 10 and 11 were rejected under 35 USC 103(a) as being unpatentable over Smith in view of US Patent No. 5,619,834 to Chen.

The Examiner has indicated that the foregoing rejection is made for the reasons set forth in Issue 3 regarding Elmendorf. The patentee respectfully submits that the remarks hereinabove responsive to Issue 3 apply with equal or greater force to the combination of Smith with Chen instead of with Elmendorf.

Chen is directed to a slate positioning device comprising a positioning plate having a horizontal plate and first and second longitudinal plates at two ends of the horizontal plate. The first longitudinal plate has a hole, and the second longitudinal plate has upper and lower convex edges. A screw rod passes through the hole and the slot to fasten the first longitudinal plate and the pad plate. The upper convex edge and lower convex edges are inserted into corresponding grooves of corresponding slates. The Chen device necessarily includes multiple pieces to provide its adjustability, rendering it far more complicated to fabricate and install than the Eberle device.

Significantly, the slate positioning device of Chen is usable only with a wall construction in which the device holds the covering slates away from the underlying wall structure. This outward spacing is a direct consequence of the presence and size of a horizontal plate structure, such as single piece horizontal plate 42 of Fig. 5 or the combination of members 61 and 42' of Figs. 11-12. The Chen device is bolted to the underlying wall structure, e.g. by bolt 400. Were these horizontal plate structures and the resulting outward spacing eliminated, there would be no access for inserting and securing

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 38

bolt 400. Importantly, there is no hole or other similar structure in the Chen device adapted to function as the patentee's attachment orifice, such as Chen's second longitudinal plate 40, which the Examiner has equated to the Eberle biscuit top element. Still further, all the disclosed embodiments of the Chen bracket include two longitudinal plates in parallel planes, whereas the Eberle device has only a single flat top element. Eliminating either longitudinal plate of Chen would clearly defeat its operation.

Like Weiland and Elmendorf, Chen only discloses embodiments wherein an attachment device is disposed solely at the corners of workpieces being secured to an underlying structure, be it a wall, ceiling, or floor, i.e., at vertices having interior or exterior 90° angles. The patentee thus maintains that the Examiner has not pointed to any evidence demonstrating motivation to combine any of these references, which admittedly disclose non-rectangular shapes for certain devices, with the T-shape, rectangular-top device of Smith. Nonetheless, the Examiner has combined these references with devices such as those of Smith and Heilmann (discussed further in Items 8-10 below), that engage workpieces along their sides, but only with attachment fixtures that have rectangularly shaped tops for the engagement. It is thus respectfully submitted that the combinations have been made only on the basis of impermissible hindsight reconstruction.

The patentee submits that the person having ordinary skill in the art for the purpose of the determination of the obviousness of the Eberle device is a tradesperson experienced in the field of carpentry, including wooden deck building. The patentee continues to maintain the position that such a person would not have been motivated to

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 39

consider the combination of the Chen device with the subject matter of Smith, given the markedly different problems of installing relatively light wood flooring and massive stone or slate panels as a wall construction. Clearly, neither the Eberle device nor the Smith device is required to sustain any substantial static loading. The flooring being installed in accordance with the Smith teaching bears on a subfloor, so the device merely has to restrain the flooring against relatively small forces involving lateral movement of the individual pieces, warpage, and the like. On the other hand, in the Chen construction, the device is the only means by which the stone wall structure is supported. The Chen devices must collectively sustain the static weight of the entire wall, as well as prevent relative motion of the individual panels. The requirements and sizing of such devices are thus altogether different.

The courts have unequivocally recognized that a general relationship between two references is insufficient to predicate a combination, absent a specific suggestion for the combination. See, e.g. *Interactive Techs., Inc. v. Pittway Corp.*, Civ. App. No. 98-1464, slip op. at 13, 1999 U.S. App. LEXIS 11166, (Fed. Cir. June 1, 1999) (unpublished), *cert. denied*, 528 U.S. 1046 (1999). [“The sole evidence proffered of a motivation to combine was that several prior art patents mentioned there being a similarity between garage door openers and home security systems. However, such limited evidence of there being a general relationship between the fields does not suggest a motivation to combine the particular references here relied upon by the Pittway parties.”] See also *In re*

*Alhamad*, Civ. App. 97-1345, slip op. at 3-4, 1997 U.S. App. LEXIS 38110 (Fed. Cir. Dec. 18, 1997).

The patentee maintains that the Examiner's contention that both the Smith and Chen devices relate to construction fasteners or the attachment of veneers at best demonstrates no more than a general relationship of the type that the courts have deemed insufficient. Absent express establishment of another motivation, as required under *In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002), the combination of Smith and Chen is submitted to be improper.

Attention is respectfully directed to the Rule 132 Declaration by Sabin in support of the patentability of the present patent claims. The Patent Owner submits that the Declaration provides additional bases establishing that even in combination, Smith and Chen do not disclose or suggest the subject matter of claims 10-11. The Sabin Declaration further provides evidence tending to establish that a person having ordinary skill in the art would not have had motivation to modify the combined teaching of Smith and Chen as would be required to reach the present claimed anchoring biscuit device.

Accordingly, and in view of the foregoing arguments, the amended and newly presented claims, and the Declarations supporting patentability that are appended hereto, reconsideration of the rejection of claims 10-11 under 35 USC 103(a) as being unpatentable over Smith and Chen is respectfully requested, along with confirmation of said claims, as amended, and allowance of newly presented claims 13-26.

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 41

Although not specifically given enumeration as a separate issue, the Examiner appears to have included under the heading "Issue 7" a further and separate rejection of claim 12 under 35 USC 103(a) as being unpatentable over Smith in view of Chen and further in view of Wothe. The Patent Owner respectfully maintains that Wothe does not cure the lack of disclosure or suggestion of the subject matter of base claim 10, on which claim 12 depends. Accordingly it is submitted that this rejection is also untenable for at least the same reasons.

Reconsideration of the rejection claim 12 under 35 USC 103(a) as being unpatentable over Smith in view of Chen and further in view of Wothe is thus respectfully requested, along with confirmation of claim 12.

**Issue 8:**

Claims 1, 2, 7, 8, 9, and 10 were rejected under 35 USC 103(a) as being unpatentable over Heilmann in view of Elmendorf, or, in the alternative, over Heilmann in view of Elmendorf and further in view of Weiland.

Heilmann is directed to a fireproof covering system for frame structures that is said to cause the structure to have the appearance of a stone building. The covering comprises blocks, plates, or slabs. The construction disclosed by Heilmann entails use of a generally T-shaped washer, as depicted by Fig. 4, that engages grooves in the sides of the slabs, plates, or blocks used. Significantly, the construction further calls for the joints between the adjoining blocks to be filled with cement mortar, which is clearly essential

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 42

for the covering to retain its fireproofing ability. In particular, the lower blocks are said to be first set in cement mortar (page 1, col. 2, lines 55-57). The Fig. 4 washers are then placed in grooves in the sides of the lower blocks and secured by nails, screws, or other fasteners (line 96). The connection is described as “tongue and groove” (line 93). Mortar is spread in the grooves of each course before the next course is laid. (“...the spreading of mortar first done, of course, before another course is laid.” Page 1, col. 2, lines 79-81, emphasis added). Moreover, all the remainder of the joint, apart from the location of the washers, is filled with mortar, e.g. by a pointing operation (line 104 and material *f* of Fig. 3). The mortar filling is said to provide a firm and solid connection of the blocks with each other, so that a practically monolithic facing is produced. (lines 99-103).

The Examiner has contended that Heilmann discloses the claimed anchoring system apart from the shape of the top element and the requirement of at least two vertical support members. He further has asserted that it would have been an obvious design choice to select a biscuit shape for the Smith [*sic* – *Heilmann may have been intended*] anchor device given the Elmendorf teaching.

The Examiner further has acknowledged that Heilmann is further lacking in that only one vertical member is provided. However, the Examiner further asserted that the “vertical member in Eberle is essentially a single planar member with a gap or spacing in the middle where there is an absence of material” as the basis for an assertion denying any substantive difference between that Eberle’s two-vertical member device and

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 43

Heilmann's single vertical member device. The patentee agrees that the width of the joint between blocks in the Heilmann construction is defined by the lateral width of the shoulder  $d$  of the Fig. 4 device. However, attention is respectfully drawn to the Heilmann reference at page 1, col. 2, lines 53-54, which discloses a perforation or hole  $d'$  that passes "through the main body of the washers and through the ribs or shoulders  $d$  (emphasis added). Fig. 3 clearly discloses a construction employing a device having such a perforation.

The Examiner has proposed a modification of the Heilmann washer device in which the thickness of the rib  $d$  is reduced enough to convert the single rib, e.g. as shown in Heilmann's Fig. 3, into two separate, collinearly disposed ribs. The patentee respectfully maintains that nothing in the Heilmann disclosure supports, let alone suggests, such a radical reconstruction. To the contrary, and if so modified, such a device could not properly be characterized as having a hole that extends through both the body and the shoulder of the device, as taught at col. 2, lines 53-54. Clearly, the hole would no longer extend through the shoulder, negating the Examiner's proposal.

Moreover, it is submitted that a person having ordinary skill in the art would regard the hole  $d'$  in the Heilmann device as being relatively small, i.e. sized to provide clearance for a screw, nail, or fastener used for its attachment, but not significantly larger. The hole clearly would have to be small enough that the head of the fastener could not pass through, lest the fastening function be defeated. Still further, in the Examiner's modification, the thickness of  $d'$  would inherently have to be less than the shank diameter



Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 44

of the fastener. Therefore, the possible gap between blocks would be severely constrained to the very small values imposed by the diameters of suitable fasteners. Alternatively stated, the fastener shank diameter would have to be greater than the gap between blocks. Reduction of thickness  $d'$  to less than a fastener shank diameter would be highly problematical. Once the fastener were to be driven, its shank would necessarily disrupt the edge of the block.

Many of the block materials used in the Heilmann construction would be hard and/or brittle materials, such as stone or concrete slabs or composition tiles. In some cases, a typical metal fastener (e.g. screw or nail) would be unable to penetrate the facing block. In others, the facing block would be highly prone to severe edge damage. Either outcome could be clearly untenable. Accordingly, the patentee maintains that a person having ordinary skill in the art would be motivated not to carry out the Examiner's proposed extensive reconstruction, recognizing that such a reconstruction would render the Heilmann device inoperative for its appointed function.

A further problem negating motivation for the proposed reconstruction stems from the risk that fireproofing would be compromised. A skilled artisan would recognize that fully enclosing the fasteners in a mortar or cement filling enhances fireproofing. On the other hand, the presence of air pockets, that are highly likely to result if the fasteners were modified in the proposed manner, would result in a degraded firewall. The heat rating and efficiency of such modifications would be unacceptable. In any event, there is

no teaching or suggestion to make this modification of the Heilmann disclosure, even in light of the Elmendorf or the Elmendorf and Weiland teachings.

The patentee further points to a benefit afforded by the Eberle device. Because the attachment orifice is separate from the vertical projections, the Eberle device permits a decking system to be installed with fasteners driven at an off-vertical angle, e.g. as shown in Fig. 9 and described at col. 6, lines 6-23. This construction provides improved attachment (see lines 18-19). Significantly, no such benefit or configuration is recognized by Heilmann, or even possible using the disclosed device.

Still further, it is submitted that a reconstruction that vitiates a recited feature (the single shoulder *d* of the Heilmann device) inherently cannot be regarded as an obvious modification.

For at least the reasons set forth above, the patentee traverses the combination with Elmendorf, for reasons set forth hereinabove. In arguing the rejection of the present claims over Heilmann and Elmendorf, the requester points to the disclosure of Heilmann that “the washers D [may be] of any suitable form” (Heilmann, p. 1, col. 1, lines 46-47). By way of contrast, the patentee draws attention to the fuller context of this phrase. Conspicuously absent from this limited quotation is the remainder of the sentence, and the next sentence, which call for the washer “[to be] provided with longitudinal shoulders or ribs *d*, so that a washer is produced which has a T-shaped cross-sections. These washers are provided with preferably central perforations or holes *d'*, that pass through the main body of the washers and through the ribs or shoulders *d*.” The patentee again

submits that the combination is argued, without justification and in hindsight, between a flat device such as Elmendorf, and a rectangular or rectilinear-topped device, such as Heilmann's.

The patentee's remarks under Issue 3 above concerning the original BPAI decision are submitted to be equally pertinent to the rejection over Heilmann and Elmendorf, as the Examiner again has incorrectly characterized the BPAI decision as being made in relation "to an anticipation rejection of a biscuit shape" (Office Action, page 24, first full paragraph, line 3). Moreover, the Examiner has alleged that the Board's rejection of the Ellinwood-Bischof combination was "due to the fact that the figure used to show the biscuit shape was not in fact a biscuit or anchor, but instead a template...). However, the Board did not so limit its consideration, and further stated that "Although Bischof's connecting element is somewhat more pertinent, its structure and function still differ markedly from those of Ellinwood's connecting element. The friction-reducing rationale advanced by the examiner to support the combination of these two references is quite strained, and highlights the impermissible hindsight-driven impetus for the combination." (page 7 of BPAI decision). Clearly, the Board recognized that biscuit shapes for construction devices were known, but considered the substitution of such a shape for a rectangular shaped top in an attachment device such as Heilmann's not to be obvious.

For the foregoing reasons, it is submitted that a person having ordinary skill in the art would not regard Heilmann as disclosing or suggesting any device having at least two

vertical projections, as delineated by amended claim 1 (and claims 2, 7, 8, and 9 dependent thereon), or exactly two vertical projections, as provided by new claim 14 (and claims 15-19 dependent thereon).

The patentee also maintains that Heilmann like Smith, discloses only a device having a rectangular top configuration. For the reasons set forth hereinabove under Issue 7, it is maintained that no motivation has been adduced for combining a reference disclosing a rectangular top element appointed to engage workpieces along their sides with references having a non-rectangular element, but only disclosed for engagement of workpieces at their corners.

The Examiner's rejection further includes claim 10. As now amended, claim 10 calls for at least one substantially vertical support member that is located off-center and to one side of at least one attachment orifice. No remarks in the present rejection specifically address this claim. However, the patentee maintains that Heilmann discloses only a hole that extends through both the top and shoulder *d* of his attachment means. Such disclosure clearly does not satisfy the limitation of a support member that is to one side of an attachment orifice. Nothing, either in Heilmann itself or the foregoing modification proposed by the Examiner, would provide this feature. Accordingly, it is submitted that amended claim 10 is not obvious over Heilmann. The same considerations also predicate patentability of new claim 20, which calls for exactly one off-center support member that also is to one side of an attachment orifice.

The Examiner has further alleged, in the alternative, that claims 1, 2, 7, 8, 9, and 10 are obvious over the combination of Heilmann, Elmendorf, and Weiland. He has stated that it is widely accepted in the constructional anchor art that spacing between adjacent structures (e.g., tile, boards, etc.) may either be defined by a single unitary spacing member, as in Heilmann, or a plurality of spaced members, as shown by Weiland. In particular, he pointed to Fig. 6 of Weiland as opposed to his Fig. 4, alleging that the spacing is the same in both embodiments only with the first spacer having a unitary member and the latter having a plurality of members. He concluded that it would have been obvious to those having ordinary skill in the art at the time of the invention to have formed the Heilmann vertical spacer as plural smaller vertical members as a matter of choice in design.

The patentee respectfully traverses this contention. Fig. 4 of Weiland provides a device having four radially extending portions 13 that are said to be "channel-like" (page 2, col. 1, lines 23-27). Those portions are located 90 degrees apart. It is further said adjacent portions 13 form, with the intervening wing or marginal portions 14, a series of right angled corner-receiving pockets *a* for positioning and retaining tiles (lines 27-31). For the reasons set forth hereinabove in connection with Issue 1, the patentee maintains that nothing in Weiland or elsewhere motivates the elimination of one set of the radially opposed portions (e.g., those at the 12 o'clock and 6 o'clock positions) and the retention of the other set of radially opposed portions (e.g., those at the 3 o'clock and 9 o'clock positions), as would be required to provide a device having its vertical support members

along the device's centerline. Furthermore, once two of portions 13 were removed, the device would no longer have right-angled pockets *a*, so that inherently it could not function to engage tiles at their corners and carry out its function of provid[ing] an accurate spacing and confining security for the tiles" (lines 39-41).

The patentee further maintains that while features 13 of Fig. 4 of Weiland are denominated as "channel-like portions," they would not be regarded by a skilled person as being separate, substantially vertical support members, as that nomenclature is used in the present specification. Rather, they must be regarded as a single member. Fig. 4 of Weiland thus cannot be regarded as disclosing or suggesting any embodiment having at least two substantially vertical support members. Even less would the Fig. 4 embodiment be regarded as providing an attachment orifice that is between two members, as also required by claim 1. Instead, the orifice clearly passes through a single member.

The Examiner's attention is respectfully drawn to the Rule 132 Declaration of Harry Eberle. The Patent Owner submits that the Declaration provides additional bases establishing that even in combination, Heilmann, Elmendorf, and Weiland do not disclose or suggest the subject matter of claims 1, 2, 7, 8, and 9. The Eberle Declaration further provides evidence tending to establish that a person having ordinary skill in the art would not have had motivation to modify the combined teaching of Heilmann, Elmendorf, and Weiland as would be required to reach the present claimed anchoring biscuit device.

Accordingly, and in view of the foregoing arguments, the newly presented claims and the Declarations supporting patentability that are appended hereto, reconsideration of

the rejection of claims 1, 2, 7, 8, and 9 under 35 USC 103(a) as being unpatentable over Heilmann in view of Elmendorf, or, in the alternative, over Heilmann in view of Elmendorf and further in view of Weiland, is respectfully requested, along with confirmation of said claims, as amended, and allowance of newly presented claims 13-26.

**Issue 9:**

Claims 1, 2, 7, 8, 9, and 10 were rejected under 35 USC 103(a) as being unpatentable over Heilmann in view of Chen, or, in the alternative, in further view of Weiland.

The Examiner has indicated that this rejection is made for the reasons set forth in Issue 8 regarding Elmendorf. In the present instance, the Examiner has not provided any express basis on which Heilmann and Chen are properly combined, as the courts have repeatedly required. See, e.g., *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (B.P.A.I. 1986). The patentee therefore maintains that no motivation is operative in this rejection beyond that articulated under Item 8 for the combination of Heilmann with Elmendorf and, optionally, Weiland. To the contrary, it is submitted that any motivation for the combination with Chen is negated by the structure of the Chen attachment device, including the spacing of the wall tiles away from the underlying support structure, as necessitated for accessing and tightening the securing bolt, as discussed under Item 7 above. Other reasons set forth by the patentee in this section are also as pertinent to impropriety of the combination of Chen with Heilmann as with Smith.

The Patentee also maintains that the combination of Chen with Heilmann is no more availing than the combination of Elmendorf with Heilmann. As set forth above under Issue 8, the patentee maintains that the modification of Heilmann required to provide at least two substantially vertical support members by reducing the thickness of the Heilmann shoulder *d*, as required to reach amended claim 1 (and claims 2 and 7-9 dependent thereon), would not be made by a skilled artisan, is unreasonably strained, and reflects the operation of impermissible hindsight. Chen in no way remedies such a deficiency. The at least one off-center element required by amended claim 10 also is not disclosed or suggested by Heilmann, even in combination with Chen.

Further, the patentee respectfully submits that the alternative additional combination of Weiland with Heilmann and Chen is no more availing than the combination of Weiland with Heilmann and Elmendorf as discussed in connection with Issue 8.

The Examiner's attention is respectfully drawn to the Rule 132 Declaration of Harry Eberle. The Patent Owner submits that the Declaration provides additional bases establishing that even in combination, Heilmann, Chen, and Weiland do not disclose or suggest the subject matter of claims 1, 2, 7, 8, 9, and 10. The Eberle Declaration further provides evidence tending to establish that a person having ordinary skill in the art would not have had motivation to modify the combined teaching of Heilmann, Chen, and Weiland as would be required to reach the present claimed anchoring biscuit device.



It is thus submitted that claims 1, 2, 7, 8, 9, and 10, as amended, are not obvious over Heilmann, Chen, and Weiland, whether taken singly or in any combination.

In view of the present claim amendments, the remarks set forth above, and the Declarations in support of patentability submitted herewith, reconsideration of the rejection of claims 1, 2, 7, 8, 9, and 10 under 35 USC 103(a) over Heilmann, Chen, and Weiland, and their confirmation, together with allowance of newly presented claims 13-26, are respectfully requested.

**Issue 10:**

Claims 3-6 were rejected under 35 USC 103(a) as being unpatentable over Heilmann in view of Elmendorf, or, in the alternative, in further view of Weiland, and further in view of Wothe.

As set forth hereinabove in connection with the rejection of Issue 8, the patentee traverses the Examiner's assertion that the modified Heilmann device discloses the invention as presently claimed. In particular, the patentee maintains that amended claim 1 is not disclosed or suggested by the combination of Heilmann and Elmendorf, or even alternatively in further view of Weiland, for the aforesaid reasons. Under Issue 2 above, the patentee has further differentiated Wothe, which does not cure the fundamental deficiencies of Heilmann, Elmendorf, and Weiland with respect to the features of amended claim 1, from which claims 3-6 depend. Thus, even with the disclosure of a

non-circular and elongated slot washer provided by Wothe, claims 3-6 are not disclosed or suggested as the Examiner has alleged.

The Examiner's attention is respectfully drawn to the Rule 132 Declaration of Harry Eberle. The Patent Owner submits that the Declaration provides additional bases establishing that even in combination, Heilmann, Elmendorf, Weiland, and Wothe do not disclose or suggest the subject matter of claims 3-6. The Eberle Declaration further provides evidence tending to establish that a person having ordinary skill in the art would not have had motivation to modify the combined teaching of Heilmann, Elmendorf, Weiland, and Wothe, as would be required to reach the present claimed anchoring biscuit device.

Accordingly, reconsideration of the rejection of claims 3-6 under 35 USC 103(a) as being unpatentable over Heilmann in view of Elmendorf, or, in the alternative, in further view of Weiland, and further in view of Wothe, is respectfully requested, along with confirmation of claims 3-6, as amended, over said art..

**Issue 11:**

Claims 1, 2, 3, 5, 7, 8, 9, 10, and 11 were rejected under 35 USC 103(a) as being unpatentable over Japanese Patent Publication JP 04-371657 to Hashida, or, in the alternative, Hashida in view of Weiland.

In the present instance, the Examiner has provided a translation apparently only of the abstract of Hashida, and not of the full publication. As best understood by the Patent

Owner, Hashida provides an attachment of stone boards to a wall and a fitting useful therefor.

It is respectfully submitted that the present office action reflects a practice that the Board of Patent Appeals and Interferences has eschewed as being improper, namely a rejection predicated on an English-language translation solely of an abstract of a foreign-language reference. In *Ex parte Jones*, 62 U.S.P.Q.2D (BNA) 1206, 1208 (BPAI 2001), the Board wrote as follows:

The Board of Patent Appeals and Interferences continues to have recurring problems in resolving *ex parte* appeals which come before it. One continuing recurring problem is the citation and reliance by examiners on abstracts, without citation and reliance on the underlying scientific document.

In this appeal, the examiner relied upon abstracts of three technical journal articles without referring to translations of the underlying documents. Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. Abstracts often are not written by the author of the underlying document and may be erroneous. It is our opinion that a proper examination under 37 CFR § 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document.

In the event a reference is in a foreign language, if the applicant does not wish to expend resources to obtain a translation, the applicant may wish to request the examiner to supply a translation. If a translation is not supplied by the examiner, the applicant may wish to consider seeking supervisory relief by way of a petition (37 C.F.R. § 1.181) to have the examiner directed to obtain and supply a translation. . . . In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner's rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings of

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 55

the five technical journal articles. Moreover, an evaluation of translations may eliminate the need for an appeal.

It is well established that a reference being applied in a rejection must be considered for what it would suggest, as a whole, to a person having ordinary skill in the art. Clearly, a rejection based on the translation of a small portion of such a reference cannot be regarded as being based on what the reference as a whole teaches.

The need for a translation in the present instance is particularly apparent in a comparison of Figs. 2 and 3 of Hashida. The patent owner submits that these Figures demonstrate, as best as can be ascertained without any underlying textual description, that the Hashida fastener is a two-part device that functions as a turn-button. In Figs. 2 and 3, portions 22 and 23 are differentiated by the crosshatching only of portion 22. By way of contrast, the present claimed anchoring biscuit device has vertical support members that are attached to the underside of the top element. The claimed device is preferably fabricated as a unitary object. In the Hashida device, the spacer portion (22) is used on a vertical surface to space individually installed stone panels. After a given stone is in position, the aligner portion (23) is rotated to lock in that stone and place the aligner into position to receive the next, adjacent stone. The procedure is repeated as subsequent stones are installed and the desired height is obtained. With this system, fasteners are put into position prior to installing the stone, thus assuring straight lines for grouting. This application method would not prove practical for surfaces that are installed horizontally, such as decks, because the space required to accommodate the spacer and rotating portion

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 56

for a screw would result in an excessively wide gap. Such a width would be regarded as unattractive and unsafe for a decking installation.

This usage of fitting 20 of Hashida differentiates its structure from that of the Eberle anchoring biscuit device. Fitting 20 has only a single vertical member 22 that is not attached to the top element 23. Versions of the Eberle device having two vertical support members with an attachment orifice between inherently could not function in Hashida's manner, because there would be no means of securing the top element and vertical support members with a screw or other fastener. In addition, Hashida's two-piece fastener is more complicated and difficult to fabricate than a single-piece device. The installation would require added extraneous steps during the deck installation process, including the rotation of the top element into position and a final tightening of the screw attachment that would be needed thereafter to remove play and assure adequate holding force. The attachment would not be as strong, because the width of the top element would be limited to the acceptable gap between adjacent deck boards, thus severely restricting the possible bearing area of the device. The Hashida fastener itself would have a marked weakness and propensity to break due to flexure along a line across the narrow width dimension of the top element at the screw orifice. On the other hand, the vertical support members of the Eberle device act in concert with the top element to limit flexure and provide enhanced strength. The Hashida device thus is not capable of adequately providing the Eberle support function.

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 57

Accordingly, it is respectfully submitted that a person having ordinary skill in the art would have no motivation to carry out the substantial modifications of any device constructed in accordance with the Hashida reference singly or in combination with Weiland, as would be required to reach the claimed device. Like Chen, Hashida teaches a device that must be constructed of suitable materials and given sufficient heft to secure stone wall panels in two dimensions. Any such device must both restrain the panels from becoming detached from the wall structure behind them and carry the static vertical loading of the tiles. Hashida teaches only a generally T-shaped device with a single projection from a top element. The Weiland element has multiple projections, but they are perpendicularly oriented so that they can engage relatively light wall tiles, not heavy stone panels, at their corners. The perpendicular projections of the Weiland device clearly prevent it from rotating in the manner in which the Hashida element is used

Specifically, Hashida's fitting 20 is clearly differentiated from the present claimed anchoring biscuit device. Fitting 20 has only a single vertical member 22, whereas amended claims 1-9 call for at least two substantially vertical support members and claims 14-19 call for exactly two such vertical support members. The Eberle device, having at least two members, inherently could not function in the manner proposed for the Hashida device as a result of its structure.

Like Chen, Hashida teaches a device that must be constructed of suitable materials and given sufficient heft to secure stone wall panels in two dimensions. Any such device must both restrain the panels from becoming detached from the wall

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 58

structure behind them and carry the static vertical loading of the tiles. Hashida teaches only a generally T-shaped device with a single projection from a top element. The Weiland element has multiple projections, but they are perpendicularly oriented so that they can engage relatively light wall tiles, not heavy stone panels, at their corners. The perpendicular projections of the Weiland device clearly prevent it from rotating in the manner in which the Hashida element is used

It is further submitted that Hashida, whether taken singly or in combination with Weiland, also fails to disclose or suggest the subject matter of claims 10-11 as amended, or new claims 20-26. Claims 10-11 now call for at least one off-center vertical support member. On the other hand, as best understood by the patentee, spacer 22 of the Hashida device is located on-center, not off-center, and the Examiner has not pointed to any disclosure or suggestion to the contrary or any suggestion that Hashida (even in combination with Weiland) be so modified. The same considerations are submitted to apply with equal force to claims 20-26, which require exactly one off-center vertical support.

The patentee also maintains that the considerations set forth above under Issue 7 regarding the skilled person's motivation to consider the Chen reference relating to stone panel wall construction also apply to Hashida. That is to say, a person having ordinary skill in the art to which the Eberle device pertains would not have been motivated to look to hardware and techniques used in constructing and supporting massive stone walls for combination with hardware used instead for the radially different problem of attaching

Inventor : Eberle, III  
ReExam : 90/007,661  
Serial No. : 09/186,741  
Filed : November 5, 1998  
Page : 59

decking boards. Accordingly, it is further submitted that the combination of Weiland and Hashida is not a proper predicate for the present obviousness rejection.

The Hashida prior art device, like Heilmann's metal device, prevents or inhibits insertion of an attachment screw at an angle to catch both the deck board and the board being attached as in the present invention device. Thus, this structural difference is significant. The new claims expressly indicate that the attachment orifice and the support member(s) are separate and apart from one another.

The Examiner's attention is respectfully drawn to the Rule 132 Declaration of Harry Eberle. The Patent Owner submits that the Declaration provides additional bases establishing that even in combination, Hashida and Weiland do not disclose or suggest the subject matter of claims 1, 2, 3, 5, 7, 8, 9, 10 and 11. The Eberle Declaration further provides evidence tending to establish that a person having ordinary skill in the art would not have had motivation to modify the combined teaching of Hashida and Weiland as would be required to reach the present claimed anchoring biscuit device.

In view of the foregoing remarks, the present claim amendment, and the Declarations supporting patentability that are appended hereto, it is submitted that claims 1, 2, 3, 5, 7, 8, 9, 10, and 11, as amended, are not obvious over Hashida and Weiland.

Accordingly, reconsideration of the rejection under 35 USC 103(a) of amended claims 1, 2, 3, 5, 7, 8, 9, 10, and 11 as being unpatentable over Hashida, or in the alternative, Hashida in view of Weiland, is respectfully requested, along with confirmation of said claims and allowance of new claims 13-26. In addition, and in



Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 60

accordance with *Ex parte Jones, supra*, the patentee respectfully requests that the Examiner obtain and provide a translation of the full Hashida reference and provide appropriate citation to that document to establish the propriety of any rejection based on Hashida, which has not previously been cited as prior art in the present proceeding or in the original prosecution of the subject patent.

**Issue 12:**

Claims 4, 6, and 12 were rejected under 35 USC 103(a) as being unpatentable over Hashida in view of Wothe, or, in the alternative, Hashida in view of Weiland and further in view of Wothe.

The examiner has asserted that the Hashida device as modified discloses the invention substantially as claimed, less a non-circular and elongated slot. For at least the reasons set forth above under Issue 11, the patentee respectfully disagrees, and maintains that amended claims 1 and 10 are patentable over Hashida, either singly or in combination with Weiland.

Claims 4 and 6, and 12 respectively depend on claims 1 and 10, and further require the aforementioned non-circular and elongated slot. As set forth under Issue 2 above, any disclosure by Wothe of a non-circular and elongated slot does not cure the lack of disclosure of other features of claims 1 and 10. The patentee thus maintains that claims 4, 6, and 12 are not rendered obvious by any combination of Hashida, Weiland, and Wolthe.

Accordingly, reconsideration of the rejection under 35 USC 103(a) of amended claims 4, 6, and 12 as being unpatentable over Hashida, or in the alternative, Hashida in view of Weiland, in further view of Wothe, is respectfully requested, along with confirmation of said claims.

**Further Remarks:**

The Examiner's attention is respectfully drawn to the Rule 132 Declarations of Sabin and Eberle. Set forth therein is further evidence tending to establish the novelty and non-obviousness of the present patent claims over the prior art applied. In addition, these declarations provide evidence of the industry recognition of the EB-TY® PRODUCT as satisfying a long-felt need in the art and its commercial acceptance and success.

**Conclusion:**

In view of the resubmission of the claim listing comprising amended claims 1, 2, 7, 8, and 10 and newly presented claims 13-26; the Rule 132 Declarations of Sabin and Eberle submitted in conjunction with the response filed February 9, 2007; and the remarks set forth hereinabove and in the February 9, 2007 response, it is respectfully submitted that claims 1-26 are patentable over the art of record. Entry of the present

Inventor : Eberle, III

ReExam : 90/007,661

Serial No. : 09/186,741

Filed : November 5, 1998

Page : 62

amendment, confirmation of claims 1-12, allowance of new claims 13-26, and issuance of an *Ex Parte* Reexamination Certificate, are earnestly solicited.

May 18, 2007

Date



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ReExamination of USP 6,402,415  
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Attorney Docket No.: HWE-105C

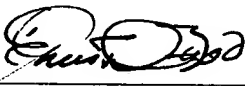
**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the attached "SUPPLEMENTAL AMENDMENT AND RESPONSE UNDER 37 CFR 1.550(b)" was served by First Class Priority Mail on the date below to:

Berenato, White, & Stavish, LLC  
6550 Rock Spring Drive, Suite 240  
Bethesda, MD 20817

Attention: Matthew W. Stavish, Esq.

May 18, 2007  
Date

  
\_\_\_\_\_  
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